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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,893	11/13/2001	Joseph E. Dryer	JDRY/0002	3130

7590

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EXAMINER

DAVIS, ZACHARY A

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/007,893	Applicant(s) DRYER ET AL.	
	Examiner Zachary A. Davis	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20020506, 20020514</u> . | 6) <input type="checkbox"/> Other: _____ |



DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 14 May 2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 151 (see page 5, paragraph 0012).

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 152, 154 (see Figure 1), and 416 (see Figure 4).

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "418" has been used to designate both the corporate intranet and the secure tunnel (see Figure 4). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of

the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities:

The specification appears to contain minor typographical and other errors. For example, in line 3 of paragraph 0011, it appears that "confidentially" is intended to read "confidentiality"; in paragraph 0012, reference number 150 is used to refer to both the Internet and the protected subnet; also in paragraph 0012, line 6, it appears that "Internet 148" is intended to read "Internet 150"; in line 1 of paragraph 0014, it appears that "possibly" is intended to read "possibility". Further, the use of the verbs "alarm" and "alert" throughout the specification is somewhat unconventional.

Appropriate correction is required. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

6. Claim 4 is objected to because of the following informalities:

Claim 4 recites the limitation "an encrypted communications" in line 2 of the claim. It appears that this is intended to read either "an encrypted communication" or simply "encrypted communications".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In reference to Claim 1, it is unclear whether the limitations "with on-the-fly encryption means" beginning in line 4 of the claim and "with on-the-fly decryption" in line 7 are intended to modify the Lockbox system of line 2, or the internal firewall or secure web server of line 4. This renders the claim indefinite. Further, the limitation "the computerized device can disable this enabling" is somewhat unclear and narrative.

Claim 2 recites the limitation "the intended recipient" in lines 5-6. There is insufficient antecedent basis for this limitation in the claims. Further, the claim recites

the limitation "that data" in line 3. Although it is clear that this limitation is intended to refer to the segregated encrypted data of line 2, the use of such pronouns should be avoided to reduce confusion.

Claim 3 recites the limitations "the recipient-initiated communication" in line 2 and "the command" in line 4. There is insufficient antecedent basis for these limitations in the claims. Further, it is unclear whether the limitation "in a form that can only be altered" is intended to modify "the data" or "secure time-stamped logging".

Claim 4 recites the limitation "the lockbox data" in line 4. There is insufficient antecedent basis for this limitation in the claims.

Claim 5 recites the limitation "the external computer companion software". There is insufficient antecedent basis for this limitation in the claims. Further, it is unclear whether the limitation "the data" in line 3 is intended to refer to the data that is encrypted in Claim 1, the encrypted data that is decrypted in Claim 1, or to the segregated or designated data of Claim 2. Additionally, the limitations "the external computer companion software then having the ability" and "and the function of backing up the Lockbox files" are generally vague and unclear. This renders the claim indefinite.

In reference to Claim 6, the limitation "an Internet or local area network interface with a firewall and a local network interface", in lines 4-5 of the claim, is generally unclear, as it is not clear how a local area network interface can include another local network interface. This renders the claim indefinite.

In reference to Claim 7, the limitation "and that a record is kept of all extraordinary measures", in lines 4-5 of the claim, is generally vague and unclear.

Claim 8 recites the limitation “the month or day” in line 2. This is somewhat vague, although it appears to refer to the current month or day.

Claim 9 recites the limitations “those client accounts” in line 2 and “the pending files” in line 3. There is insufficient antecedent basis for these limitations in the claims, although “those client accounts” appears to refer to the clients identified in the claim. Further, the use of the pronouns “them” and “their” in line 3 should be avoided. It appears that both are intended to refer to the clients of line 3.

In reference to Claim 10, it appears that “their account” in line 1 is intended to read “the client’s account”. Further, the claim recites the limitations “that account” in line 2 and “the communication” in lines 2-3. There is insufficient antecedent basis for these limitations in the claims, although it appears that “that account” is intended to refer to the client’s account of line 10.

Claim 11 recites the limitation “the remote computer can perform for the Lockbox the functions an internet communication to the intended recipient informing the recipient of the availability of the data; and establish a secure socket communication with the recipient”. This is generally unclear, especially the phrases “the functions an internet communication” and “and establish a secure socket communication”. Further, the claim recites the limitations “the Lockbox files” in lines 1-2, “the Lockbox” in line 2, “the intended recipient” in line 3, “the data” in line 4, and “the designated data” in line 5. There is insufficient antecedent basis for these limitations in the claim. Additionally, the limitation “and the function of backing up the Lockbox files” is generally vague and unclear.

Claim 12 recites the limitation "the Lockbox" in line 2. There is insufficient antecedent basis for this limitation in the claims. Further, the use of the pronouns "his" in line 1 and "that file" should be avoided. It appears that "his account" refers to the client's account, and "that file" refers to the selected file.

Claim 13 recites the limitation "the private key" in line 4. There is insufficient antecedent basis for this limitation in the claims.

Claim 14 recites the limitation "the private key inaccessible externally". This is generally vague and unclear.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-3, 6-10, and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by An et al, US Patent 6715073.

In reference to Claim 1, An discloses a system including a microprocessor-based system in which all communications with a computerized device are routed through a secure web server (column 2, lines 55-59), where the microprocessor-based system

has data encryption means and only stores encrypted data more than transitorily (column 6, lines 1-6), and where data communication is only possible after passphrase enabling of the microprocessor-based system (column 6, lines 51-52).

In reference to Claim 2, An further discloses that encrypted data is separated and designated for communication (see column 8, lines 4-11), and that the microprocessor-based system provides an internet communication to a recipient informing the recipient of data availability (column 7, lines 12-16), and establishes a secure socket communication with the recipient where the designated data can be sent to the recipient, and files sent from the recipient can be received (column 6, lines 37-39).

In reference to Claim 3, An further discloses logging and time-stamping the communications (column 10, lines 3-8).

In reference to Claim 6, An discloses a system including a dedicated processing system including a processor, memory, non-volatile storage, and a network interface (see, for example, Figure 7) that includes an operating system that can restrict access to the network interface and restrict running applications (column 7, lines 18-23), a program to allow a computer to log onto the dedicated processing system to upload files to and download files from the storage in a manner in which the files are encrypted while stored (column 6, lines 1-6), and a program that insures that files are able to be retrieved (column 6, lines 1-6).

In reference to Claim 7, An further discloses logging and time-stamping the communications (column 10, lines 3-8).

In reference to Claim 8, An further discloses the use of a non-static passphrase to unlock the system (column 6, lines 51-52).

In reference to Claims 9, 10, and 12, An further discloses identifying clients, associating files with clients, and alerting clients (column 7, lines 12-16) and that access to a client's account is restricted by passphrase (column 6, lines 51-52) and communication to and from a client is secured by encryption (column 6, lines 37-39).

In reference to Claims 13 and 14, An further discloses the use of digital signatures and public key infrastructure (column 7, line 65-column 8, line 11; column 3, lines 5-12).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 4, 5, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over An in view of DeKoning et al, US Patent 6480970.

In reference to Claims 4 and 5, An discloses everything as applied above to Claim 2. Further in reference to Claim 11, An discloses everything as applied above to Claim 10. Additionally in reference to Claims 5 and 11, An further discloses establishing a secure socket communication with a recipient where the designated data can be sent

to the recipient, and files sent from the recipient can be received (column 6, lines 37-39). However, An does not explicitly disclose the use of companion software on an external computer, where the external computer mirrors the data in the microprocessor-based system. DeKoning discloses a system that includes mirroring data between remote and local systems (column 5, lines 42-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of An by including the use of an external computer capable of mirroring and maintaining data, in order to provide consistent and reliable data backup (see DeKoning, column 1, lines 36-58; column 3, lines 54-59).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Carroll, US Patent 6105131, discloses a secure server that includes secure sessions and password protected encryption keys.
- b. Ghafir et al, US Patent 6202159, discloses a secure vault storing encrypted data in external storage.
- c. Provino, US Patent 6557037, discloses a system for connecting through a firewall using a secure tunneling scheme.

Art Unit: 2137

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A. Davis whose telephone number is (571) 272-3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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